

REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Applicants appreciatively thank the Supervising Patent Examiner, Tariq R. Hafiz, for the courtesy and effort extended to their attorney by conducting a December 7, 2005, telephone interview with Attorney Richard J. Katz. During the interview Examiner Hafiz clarified that claims 3-11, 21-29, and 39-47 would be allowable if the non-statutory subject matter rejection is overcome, and if rewritten in independent form to recite all the features of their base claim and any intervening claims.

Status of the Claims

Claims 1-54 are pending. Claims 1, 3, 19, 21, 37, and 39 have been amended. Claim 55 has been cancelled without prejudice or disclaimer of the subject matter recited therein.

Claim 1 has been objected to for containing a misspelled word. Amended claim 1 addresses this objection. Reconsideration of the objection is requested.

Claim 1 has been further amended to recite the step of “permitting the user to view the formula.” As originally filed, claim 1 inferentially recited this step in reciting “computing a sustainability score . . . utilizing the at least one non-economic factor in a formula that is viewable by the user through the interface.” Thus, Applicants submit that this amendment merely makes express a step that was part of original claim 1 and does not change the scope of

the claim. If the Examiner disagrees, and believes this amendment narrows the scope of claim 1, Applicants request that the Examiner inform the Applicants of this interpretation, so that the Applicants may reconsider this amendment.

Claims 3 and 39 have been amended to be in independent form and to recite all the features of their base claims and any intervening claims.

Claim 19 has been amended to recite the function of “outputting the sustainability score” as part of the “means for displaying.”

Claim 21 has been amended to recite all of the elements of original claim 19.

Claims 37 has been amended to correct a misspelling.

No new matter has been added.

Status of the Specification

The Specification has been amended to address typographical errors of a clerical nature, including those identified by the Examiner. The Specification has also been amended to correctly reference character 748 in Figure 7. Additionally, the Specification has been amended to reference character 324 “Sound Card” in Figure 3.

A substitute Abstract, which complies with the requirements set forth by 37 C.F.R. 1.72(b), has been included in the present Amendment.

No new matter has been added to the Specification. Applicants appreciate the Examiners assistance in identifying the need for these amendments.

Applicants request reconsideration and withdrawal of the objection

Rejections under 35 U.S.C. § 101

Claims 1-55 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Claim 55 has been cancelled, and so the rejection with respect to claim 55 is now moot.

The Examiner contends that the processes of claims 1, 19, and 37 “calculate and output a sustainability score” and that since “the claimed process manipulates only numbers, abstract concepts, or ideas, or signals representing any of the foregoing, the claims are not being applied to appropriate subject matter.” (Detailed Action, item 8; page 5.)

A claimed computer-related process is statutory subject matter if it is “limited by the language in the claim to a practical application within the technological arts.” *See In re Alappat*, 33 F.3d 1526, 1543, 31 USPQ2d 1545, 1556-57 (Fed. Cir. 1994) (quoting *Diamond v. Diehr*, 450 US 175, 192, 209 USPQ 1, 10 (1981)). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible, and useful result. *See State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368, 38 USPQ2d 1530 (Fed. Cir. July 1998). The Examination Guidelines instruct the Examiner that “only one [practical application] is necessary to satisfy the utility requirement.” (MPEP § 2006.) The M.P.E.P. provides that the Examiner should point out statements made in the Specification that identify all practical applications for the invention, and that the Examiner should rely on such statements throughout the examination. (MPEP § 2006.) In the present case it appears that the Examiner has not noted the practical applications of the invention, which are clearly set forth in the Specification.

For Example, a sustainability score can characterize entities in terms of their “societal and environmental responsibility and impact, their economic performance, as well as their corporate governance.” (Specification, page 1, lines 5-8.) Specifically, a sustainability score

can be used when making investment decisions based on factors that go beyond simple financial return and extend into environmental and societal impact. (Specification, page 1, lines 11-14; and page 4, lines 21-30.) A sustainability score computed and output by the claimed invention is clearly a concrete, tangible, and useful result.

In *State Street Bank*, 149 F.3d 1368, 38 USPQ2d 1530, the Federal Circuit found that “a final share price momentarily fixed for recording and reporting purposes . . . and relied upon by regulatory authorities” produced a “useful, concrete and tangible result.” *State Street Bank*, 149 F.3d at 1373, 38 USPQ2d at 1535 (Fed. Cir. July 1998) (emphasis added). Just as true, the claimed sustainability score is a concrete, tangible, and useful result that may be relied upon by users when making investment decisions.

Socially responsible investing, or moral investing, has recently garnered increased attention and importance. However, the standards or measures by which an investment is considered moral or responsible are difficult to quantify and vary from person to person. The claimed invention provides investors with a sustainability score as a concrete metric of a company’s performance beyond mere financials. Thus, the invention provides a way to quantify an investment opportunity by how morally or socially responsible the company acts. Therefore, investors can characterize and measure those factors that affect one’s own conscience. The measurement of those factors is a concrete, tangible, and useful result that is manifested in a computed score that is output to the user.

Moreover, the claimed invention is particularly useful given the variation from person to person of what is considered “sustainable.” A user of the claimed invention can view the formula utilized in calculating the sustainability score. (See, claims 1, 3, 19, 21, 37, and 39.) This provides a measure of confidence in the result, and allows a user to decide for themselves if

the metric is being quantified in a manner acceptable to the user. Additionally, by allowing a user to enter coefficients to weight various data elements, as recited in independent claims 1, 3, 19, 21, 37, and 39, the claimed invention enables a user to customize the calculation of the score, thereby addressing differences in opinion of what constitutes responsible investing, while outputting a score on which investment decisions can be made.

The claimed invention can incorporate economic and non-economic factors into the sustainability score, outputting to investors a rating to assist in making more informed investment decisions. For example, by investing in entities that are sustainable over the long run based on financial and/or non-financial data, an investor may experience a better rate of return. A measurement that accounts for risk from negative environmental impact, social irresponsibility, or potential corporate governance scandals improves one's decision making process. (Specification, page 4, lines 25-30.) Again, this aspect of the claimed invention results in a concrete, tangible, and useful result insofar as the output sustainability score is not materially different than the statutory computation of price in *State Street Bank*, 149 F.3d 1368, 38 USPQ2d 1530.

Claims 1-54 recite more than the mere manipulation of an abstract idea or a disembodied mathematical algorithm. The claimed invention provides results which are "useful, concrete, and tangible." For at least the foregoing reasons, Applicants submit that the claimed invention is statutory subject matter.

Allowable Subject Matter

Applicants appreciatively acknowledge the Examiner's indication that claims 3-11, 21-29, and 39-47 would be allowable if the non-statutory subject matter rejection is overcome

and if rewritten in independent form to recite all the features of their base claim and intervening claims. Applicants have amended claims 3, 21, and 39 to be in independent form and to recite all the features of their base claims 1, 19, and 37 respectively.

Accordingly, Applicants submit that claims 3-11, 21-29, and 39-47 are in condition for allowance, and, as demonstrated above, recite statutory subject matter.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 19, 20, 37, 38, and 55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by O'Connor, *The RioJo Dashboard of Sustainable Development Indicators*, July 2002 [GOOGLE] ("O'Connor").

Claim 55 has been cancelled, and so the rejection with respect to claim 55 is now moot.

Amended claim 1 recites the step of "enabling the user to view the formula through the interface." Original claim 37 recites "an interface configured . . . to display a formula useful in computing a sustainability score." Similarly, claim 19 recites a "means for displaying . . . a formula that generates a sustainability score." Applicants respectfully submit that O'Connor neither teaches nor fairly suggests displaying or enabling a user to view the formula used for computing a sustainability score.

The ability to view the formula used in calculating the sustainability score is a substantial departure from the cited references. This feature allows the user to interrogate the program for the basis on which the sustainability score was computed. Viewing the formula behind the calculation allows the user to better understand the rating, and formulate an educated opinion whether to agree or disagree with the rating.

Therefore, O'Connor does not anticipate claims 1, 19 and 37.

Claims 2, 20, and 38 depend from claims 1, 19, and 37, respectively. Therefore, by virtue of their dependency, for at least the reasons discussed with respect to claims 1, 19, and 37, O'Connor does not anticipate claims 2, 20, and 38.

Reconsideration and withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 12-18, 30-36, and 48-54 stand rejected under 35 U.S.C. § 103(a) as being obvious over O'Conner in view of Australian Patent Application No. 2002301158 to Burt et al. ("Burt").

Claims 12-18 depend from claim 1. Claims 30-36 depend from claim 19. Claims 48-54 depend from claim 37. By virtue of the dependency from claims 1, 19, and 37, claims 12-18, 30-36, and 48-54 recite the feature of a formula that is viewable by the user.

As noted above, O'Conner does not teach or suggest a formula that is viewable by a user. Neither does Burt provide any teaching or suggestion that a formula for computing any score be viewable by the user. Thus, Applicants submit that the combination of O'Connor and Burt cannot teach or fairly suggest a formula that is viewable by the user, and does not address user concerns as to the basis for ratings calculations - unlike the claims under this rejection.

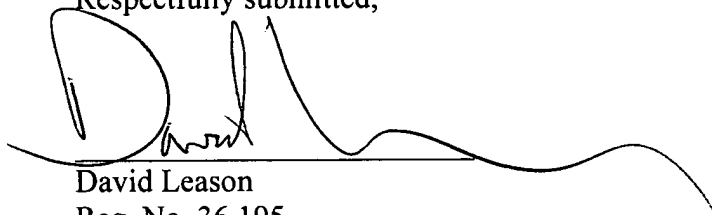
Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

Each and every point raised in the Office Action dated November 15, 2005, has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-54 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Leason', is written over a horizontal line.

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AMENDMENTS TO THE DRAWINGS

The replacement drawing sheet No. 9, which is presented in **Attachment A**, includes changes to Figure 9. Specifically, changes were made to the figures referenced within the text blocks. These changes conform to the request made by the Examiner. For example, previously, Figure 9 referred to Figures 10X, indicating any of the sub-figures of Figure 10. Because Figure 10 does not have a sub-figure "X," this reference was changed to refer to Figures 10A-E. No new matter has been added

Attachment A: Replacement Drawing Sheet